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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/873,978	06/12/97	KAYYEM	J A-63761-1/RF

HM12/0430

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EXAMINER

MARSCHER, A

ART UNIT

PAPER NUMBER

1634

12

DATE MAILED:

04/30/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/873,978

Applicant(s)  
Kayyem et al.

Examiner  
Ardin Marschel

Group Art Unit  
1634



☒ Responsive to communication(s) filed on Jan 7, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 33 and 36-44 is/are pending in the application.

~~Of the above, claim(s) 1-32, 34, 35, 45, and 46 have been canceled. is/are withdrawn from consideration.~~

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 33 and 36-44 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, ~~Paper Notes~~ (11 sheets)

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Applicants' election without traverse of Group IV, claims 33 and 36-44 in Paper No. 11, filed 1/7/99, is acknowledged.

Claims 36-39 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 36 and 39 give B-D as a conjugated bond which is confusing in citing two entities "B" and "D". What are these? There is no separate definition of "B" nor a definition of what "D" is if  $g = 1$ . Clarification is requested.

Claims 36 and 39 are vague and indefinite in citing "preferably" in lines 11 and 12, respectively, without clarifying what causes the preference to occur.

Claims 37 and 40 are vague and indefinite in giving "C" as carbon in a chain wherein the carbon only has two bonds attached thereto. Carbon has four bonds in stable attachments that may be in single, double, or triple bonded configurations but this is confusing since G is cited as a bond that seems to be a single bond.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States

before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 36 and 38 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Ribí et al. (P/N 5,571,568).

Ribí et al. discloses in column 3, lines 18-44, an electrode sensor device with electrically conductive polymers thereon with binding pair members attached thereto. In column 4, lines 34-43, polystyrene is described as one of said polymers. It is noted that polystyrene is an aromatic polymer, containing benzene (phenyl) moieties, as also required in instant claim 1, moiety "Y". Nucleic acid polymers are covalently attached to said polymeric layer as given in column 8, line 63, through column 9, line 7. These disclosures result in anticipating the above listed claims.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 33, 36, 37, and 39-44 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 29 and 32-39 copending application Serial No. 08/743,798. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

The disclosure of U.S. Patent applications for consideration cannot be cited on PTO Forms 892 or 1449 due to a lack of a date of publication. However, the following disclosed applications are hereby indicated as having been considered: Application serial numbers: 08/475,051; 08/660,534; 08/659,987; 08/873,598; 08/786,187; 08/843,623; 08/743,798; 08/709,265; 08/709,263; 08/946,679; 08/911,085; and 08/889,510.

The disclosure is objected to because of the following informalities:

Claims 37 and 40 do not end with a period as required for all claims.

Appropriate correction is required.

No claim is allowed.


Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

April 26, 1999

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER